

## **REMARKS**

Claims 1, 2, and 4-22 are pending in this application. By this Amendment, claims 1 and 11 are amended, and new claims 17-22 are added. Support for the amendment may be found in, for example, at least pages 40-43 of the specification and corresponding figures. No new matter is added. Reconsideration of the application is respectfully requested.

### **I. Claims Define Patentable Subject Matter**

The Office Action: (1) rejects claims 1-4 and 6-16 under 35 U.S.C. § 102(e) as being anticipated by *Minabe '038* (U.S. Patent Publication No. 2004/0029038); (2) rejects claims 1-16 under 35 U.S.C. § 103(a) as being unpatentable over *Minabe '038*; (3) rejects claims 1-4 and 6-16 under 35 U.S.C. § 102(a) as being anticipated by *Minabe JP '897* (Japanese Patent Publication No. 2004-059897); (4) rejects claims 1, 2, and 11-16 under 35 U.S.C. § 102(e) as being anticipated by *Minabe '095* (U.S. Patent Publication No. 2004/0190095); (5) rejects claims 1 and 2 under 35 U.S.C. § 102(e) as being anticipated by *Minabe JP '652* (Japanese Patent Publication No. 2001-294652); (6) rejects claims 11 and 12 under 35 U.S.C. § 103(a) as being unpatentable over *Matsumoto* (U.S. Patent No. 4,983,318); and (7) rejects claims 1, 2, and 11-16 under 35 U.S.C. § 103(a) as being unpatentable over *Minabe JP '652*.

The Office Action also provisionally rejects claims 1 and 2 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of copending U.S. Application No. 11/037,359 in view of *Minabe JP '652*. Applicants respectfully traverse the rejections of the claims.

#### **A. Claims 4-10 are Patentable Over Cited Prior Art**

With respect to the rejections of claims 1, 2, and 4-16, Applicants respectfully assert that *Minabe '038*, *Minabe JP '897*, and *Minabe '095* do not qualify as prior art, because each of their effective dates as prior art is later than the earliest priority date of the subject matter recited in claims 1, 2, and 4-16 for the above-identified application. Applicants respectfully

note that this application claims priority to Japanese Patent Application No. 2003-81291, which was filed on March 24, 2003 and discloses at least the subject matter recited in claims 1-16. A certified copy of the English translation of Japanese Patent Application No. 2003-81291 is hereby attached.

Specifically, *Minabe '038* was filed on June 5, 2003 and published on February 12, 2004, both of which are antedated by the earliest priority date of this application. Next, *Minabe JP '897* was published on February 26, 2004, which is antedated by the earliest priority date of this application and thus does not qualify as prior art under § 102(a). Lastly, *Minabe '095* was filed on September 11, 2003 and published on September 30, 2004, both of which are antedated by the earliest priority date of this application. Accordingly, *Minabe '038* and *Minabe '095* are not "filed in the United States before the invention by the Applicants," as required by 35 U.S.C. § 102(e). Further, *Minabe '038* shares a common assignee with this application. Therefore, Applicants respectfully assert that *Minabe '038* may not be properly applied as a reference in the rejection of claims 1, 2, and 4-16 under § 103(a) even if *Minabe '038* qualifies as a reference under § 102(e).

Moreover, *Minabe '038* claims priority from Japanese Application Nos. 2002-167796 and 2003-126692, which correspond to Japanese Patent Publication No. 2004-059897 that was published on February 26, 2004. *Minabe '095* claims priority from the same priority document as this application. Accordingly, even if Japanese patent publication identified above were relied on by the Office to reject the claims of this application, the Japanese patent publication also does not qualify as prior art under 35 U.S.C. § 102(a) because Japanese Patent Publication No. 2004-059897 is not "published before the invention," as required by 35 U.S.C. § 102(a). Therefore, none of the *Minabe '038* reference, the *Minabe '095* reference, and the Japanese patent applications from which the *Minabe '038* and *Minabe '095* references

draw priority, qualifies as prior art under any provisions of 35 U.S.C. § 102, and thus do not qualify as prior art under any provisions of 35 U.S.C. § 103.

For at least these reasons, *Minabe '038*, *Minabe JP '897*, and *Minabe '095* cannot be used to properly reject the claims of this application. Accordingly, withdrawal of the rejections of the claims 1, 2, and 4-16 under 35 U.S.C. § 102(a), § 102(e), and § 103(a) based on *Minabe '038*, *Minabe JP '897*, or *Minabe '095* is respectfully requested.

**B. Claims 1, 2, and 11-22 are Patentable Over Cited Prior Art**

**(i) Minabe JP '652**

With respect to claims 1, 2, and 11-22, Applicants assert that *Minabe JP '652* fails to disclose or suggest a method of producing an optical recording medium having a recording layer that includes a photo-responsive polymer material, the method including at least forming the photo-responsive polymer material into a plate shape having a thickness of 0.1 mm to 5 mm by hot-pressing, wherein the recording layer is formed independent of a substrate, and wherein the optical recording medium has no substrate, as recited in independent claim 11 and similarly recited in independent claims 1 and 17.

In contrast, *Minabe JP '652* discloses an optical recording medium which includes a photo-reactive polyester having a molecular structure capable of photoisomerization (translation of *Minabe JP '652*, ¶¶ [042]-[045]). The photo-reactive polyester is part of an optical recording constituent, which may include other components such as a plasticizer and polymeric materials (translation of *Minabe JP '652*, ¶¶ [065]-[068]). *Minabe JP '652* discloses that the whole optical recording medium can be formed from the optical recording constituent, or from the optical recording constituent fabricated on a substrate (*Minabe JP '652*, ¶¶ [069]-[072]).

However, *Minabe JP '652* does not teach or suggest a method of producing an optical recording medium having a recording layer that includes a photo-responsive polymer

material, the method including at least forming the photo-responsive polymer material into a plate shape having a thickness of 0.1 mm to 5 mm by hot-pressing, wherein the recording layer is formed independent of a substrate, and wherein the optical recording medium has no substrate, as recited in claim 11 and similarly recited in claims 1 and 17.

Therefore, Applicants submit that independent claim 11 is patentable over *Minabe JP '652*. Claims 12-16 depend from claim 11, and therefore, also define patentable subject matter, as well as for the additional features they recite. Independent claim 1, although of different scope, recites features similar to those of claim 11 that define patentable subject matter. Thus, Applicants submit that independent claim 1 is also patentable over *Minabe JP '652*. Claim 2 depends from claim 1, and therefore, also defines patentable subject matter, as well as for its additional recited features. Accordingly, Applicants respectfully request the withdrawal of the § 103(a) rejection of claims 1, 2, and 11-16 based on *Minabe JP '652*, and submit that new claims 17-22 are patentable over *Minabe JP '652*.

**(ii) Matsumoto**

With respect to claims 11, 12, 17, and 18, Applicants assert that *Matsumoto* fails to disclose or suggest a method of producing an optical recording medium having a recording layer that includes a photo-responsive polymer material, the method including at least forming the photo-responsive polymer material into a plate shape having a thickness of 0.1 mm to 5 mm by hot-pressing, wherein the recording layer is formed independent of a substrate, and wherein the optical recording medium has no substrate, as recited in independent claim 11 and similarly recited in claim 17.

Specifically, *Matsumoto* discloses a method for performing electric field orientation of liquid crystal polymers that includes processing the liquid crystal polymers into a shaped article (*Matsumoto*, col. 11, ll. 31-43). *Matsumoto* discloses that processing the liquid crystal polymers into a shaped article using a molding technique such as injection molding, melt

extrusion, hot-press method, casting, or spin-coating of a solution of the liquid crystal polymer in a suitable solvent (*Matsumoto*, col. 11, ll. 33-41).

However, *Matsumoto* does not teach or suggest a method of producing an optical recording medium having a recording layer that includes a photo-responsive polymer material, the method including at least forming the photo-responsive polymer material into a plate shape having a thickness of 0.1 mm to 5 mm by hot-pressing, wherein the recording layer is formed independent of a substrate, and wherein the optical recording medium has no substrate, as recited in claim 11 and similarly recited in claim 17.

Therefore, Applicants submit that independent claim 11 is patentable over *Matsumoto*. Claim 12 depends from claim 11, and therefore, also defines patentable subject matter, as well as for its additional recited features. Independent claim 17, although of different scope, recites features similar to those of claim 11 that define patentable subject matter. Thus, Applicants submit that independent claim 17 is also patentable over *Matsumoto*. Claim 18 depends from claim 17, and therefore, also defines patentable subject matter, as well as for its additional recited features. Accordingly, Applicants respectfully request the withdrawal of the § 103(a) rejection of claims 11 and 12, and submit that new claims 17 and 18 are patentable over *Matsumoto*.

**(iii)Copingding Application No. 11/037,359 in view of Minabe JP '652**

With respect to the provisional rejection of claims 1 and 2 on the ground of nonstatutory obviousness-type double patenting, Applicants assert that claims 1-16 of copending Application No. 11/037,359 in view of *Minabe JP '652* fail to teach or render obvious an optical recording medium having a recording layer which is formed into a predetermined shape with a thickness of 0.1 mm to 5 mm, where the recording layer is formed into a plate shape and sandwiched between a pair of protective substrates, as recited in independent claim 1.

Claim 2 depends from claim 1, and therefore is also not taught or rendered obvious by copending Application No. 11/037,359 in view of *Minabe JP '652*. Accordingly, Applicants respectfully request the withdrawal of the provisional double patenting rejection of claims 1 and 2.

## **II. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration 1, 2, and 4-16 and prompt allowance of claims 1, 2, and 4-22 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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JAO:JCL/dxc

Date: April 11, 2007

Attachment: Certified Copy of the English Translation of Priority Document Japanese  
Patent Application No. 2003-81291

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